

## Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed March 28, 2003.

No fee is due for the addition of any new claims.

The specification has been amended to correct errors in spelling and syntax. No new matter has been added.

Claims 1-46 were pending in the Application prior to the outstanding Office Action. The Examiner restricted the claims of the application and notice of such in a telephone conversation with the attorney, Sheldon R. Meyer, on March 20, 2003. The election, without traverse of Group I, claims 1-41 is hereby affirmed and the non-elected claims have been cancelled herewith. Applicants reserve the right to re-present the non-elected claims by filing a divisional application directed thereto. It is also confirmed that the inventorship need not be amended due to the cancellation of the non-elected claims.

### **I. REJECTION UNDER 35 U.S.C. §102(B) OVER NICHOLS ET AL. (U.S. PAT. 5,361,766)**

***Claims 1, 2, 7, 8, 13-16, 21, 22, 28, 29, 34-37***

The Examiner rejected claims 1, 2, 7, 8, 13-16, 21, 22, 28, 29 and 34-37 under 35 U.S.C. §102(b) as being anticipated by *Nichols*. The Applicants respectfully traverse the rejection of claims 1, 2, 7, 13-15, 21, 22, 28, 29 and 34-37.

The Examiner argues that *Nichols* “discloses a device that has an elongated body (2) with a tapered curved tip (22) on one end...the curved tip has a first diameter that gradually increases in one dimension to a second diameter.” The Applicants submit that *Nichols* fails to disclose a “curved tip...the diameter of the ...curved tip gradually *and continuously* increases from a first diameter to a second diameter”(Emphasis added) as recited in claims 1, 7, 14, 21, 28, 29 and 35.

Referring to FIGs. 2, 4 and 6, *Nichols* illustrates a bone probe having a “distal end 22 [that] flattens into a blade-like portion 26 with a blunt tip 27 for piercing a pedicle.” See col. 2, lines 42-44. The probe disclosed in *Nichols* tapers from a shaft 20 to the blade-like portion 26, but the curved blade-like portion 26 itself has a substantially constant thickness. The tapering does not continue to the end of the instrument. *Nichols* fails to disclose a “curved tip...the diameter of the...curved tip gradually and *continuously* increases from a first diameter to a second diameter” as recited in claims 1, 7, 14, 21, 28, 29 and 35.

Since *Nichols* fails to disclose all of the features of claims 1, 7, 14, 21, 28, 29 and 35, *Nichols* cannot anticipate claims 1, 7, 14, 21, 29 and 35 under 35 U.S.C. §102(b). Dependent claims have at least the features of the independent claim from which they ultimately depend; therefore, *Nichols* cannot anticipate dependent claims 2, 13, 15, 22, 34, 36 and 37 under 35 U.S.C. §102(b). Accordingly, the Applicants respectfully request the withdrawal of this rejection.

## **II. REJECTION UNDER 35 U.S.C. §103(A) OVER *NICHOLS***

### ***Claims 3-6, 9-12, 17-20, 23-26, 30-33 and 38-41***

The Examiner rejected claims 3-6, 9-12, 17-20, 23-26, 30-33, and 38-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nichols*. The Applicants respectfully traverse the rejection of claims 3-6, 9-12, 17-20, 23-26, 30-33 and 38-41.

The Examiner argues that *Nichols* “includes all the limitations of the claims, but does not explicitly state the size of the curved tip dilator.” For the reasons given above in Section I and II, the Applicants submit that *Nichols* fails to teach or suggest a “curved tip...the diameter of the ...curved tip gradually *and continuously* increases from a first diameter to a second diameter”(Emphasis added) as recited in claims 1, 7, 14, 21, 28, 29 and 35.

Since *Nichols* fails to teach or suggest all of the features of claims 1, 7, 14, 21, 28, 29 and 35, *Nichols* cannot render claims 1, 7, 14, 21, 29 and 35 obvious under 35 U.S.C. §103(a). Dependent claims have at least the features of the independent claim from which they ultimately depend; therefore, *Nichols* cannot render obvious dependent claims 3-6, 9-12, 17-20, 23-26, 30-33 and 38-41 under 35 U.S.C. §103(a). Accordingly, the Applicants respectfully request the withdrawal of this rejection.

**III. REJECTION UNDER 35 U.S.C. §103(A) OVER *NICHOLS* IN VIEW OF *ZUCHERMAN ET AL.* (U.S. PAT. 5,836,948)**

***Claim 27***

The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over *Nichols* in view of *Zucherman*. The Applicants respectfully request cancellation of claim 27.

**IV. NEW CLAIMS**

***Claims 47-53***

Applicants respectfully submit that new claims 47-53 are allowable over the prior art.

V. CONCLUSIONS

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any deficiency or credit overpayment to Deposit Account No. 06-1325.

Respectfully submitted,

Date: \_\_\_\_\_

5/14/03

By: \_\_\_\_\_

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